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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,443	11/26/2003	Werner Gruppe	2625-030869	5973

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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,443

Applicant(s)

GRUPPE ET AL.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 11/26/03*
- 1) ☒ Responsive to ~~communication(s) filed on~~ 11/26/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

K.L. Bell

Detailed Action

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 3 and 7, Claim, and Abstract, Applicants should delete "*Interspecific*" and insert - -Interspecific- - as this term is not a Genus or species designation and therefor does not need to be set forth in italics.

B. Page 1, line 5, Applicants state the instant plant's varietal denomination is " 'GI 209/1' ". However, Fig. 1 illustrates two plants of the new variety with what appears to be a varietal denomination of 'GIESSEN 2091'. It is not understood whether two different plants

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are being described and illustrated or the same plant is being described with two different names.

Correction and/or clarification is necessary.

C. Page 1, line 10, Applicants are requested to set forth in the specification whether the parental cultivar, Shattenmorelle, has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

D. Page 1, lines 21-27, Applicants should set forth in the specification the age of the plants when described.

E. Page 1, line 30, Applicants state tree size is "small". Applicants should set forth in the specification the typical and observed tree height and diameter. The recitation "small" is vague and insufficient in this regard.

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F. Page 2, line 1, Applicants state the instant plant's hardiness is "Good". Applicants should set forth in the specification meaningful information relative to the instant plant's hardiness such as a USDA hardiness zone.

G. Page 2, line 6, Applicants should verify the trunk diameter.

H. Page 2, lines 9 and 10, Applicants state surface and flesh bark color is "Dark brown" and "Light green", respectively. Applicants should set forth in the specification a color designation for the "Dark brown" and "Light green" colorations. The recitations "Dark brown" and "Light Green" are vague and insufficient in these instances.

I. Page 2, lines 10 and 18, Applicants states "Flesh". It is not understood what applicant intends "Flesh" to mean for these characteristics. Correction and/or clarification is necessary.

J. Page 2, lines 12 and 25, Applicant states trunk and branch lenticel color is "White-cream". Applicants should set forth in the specification a color designation for the "White-cream" colorations. The recitation "White-cream" is vague and insufficient in these instances.

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K. Page 2, lines 17 and 18, Applicants state surface and flesh branch color is “Brown” and “Light yellow”, respectively. Applicants should set forth in the specification a color designation for the “Brown” and “Light yellow” colorations. The recitations “Brown” and “Light yellow” are vague and insufficient in these instances.

L. Page 2, lines 21 and 22, Applicants state branch diameter and length are “Approximately 1/3 the diameter of the trunk” and “Approximately 2/3 the length of a 1 year old trunk”, respectively. Applicants should set forth in the specification the typical and observed branch diameter and length. The recitations stated above are vague and insufficient in these instances.

M. Page 3, lines 4 and 5, Applicants state adaxial and abaxial leaf color is “Bright green” and “Light green”, respectively. Applicants should set forth in the specification a color designation for the “Bright green” and “Light green” colorations. The recitations “Bright green” and “Light Green” are vague and insufficient in these instances.

N. Page 3, line 10, Applicant states leaf division is “Leaves are entire”. This description for leaf division doesn’t make sense. It is not understood what applicants are intending this recitation to mean. Correction and/or clarification is necessary.

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O. Page 3, line 14, Applicants state petiole color is “Light greenish-brown”. Applicants should set forth in the specification a color designation for the “Light greenish-brown” coloration. The recitation “Light greenish-brown” is vague and insufficient in this instance.

P. Page 3, lines 23 and 24, Applicants state adaxial and abaxial vein color is “Yellow” and “Light yellow”, respectively. Applicants should set forth in the specification a color designation for the “Yellow” and “Light yellow” colorations. The recitations “Yellow” and “Light yellow” are vague and insufficient in these instances.

Q. Page 3, line 26, Applicants should set forth in the specification information relative to the instant plant’s fruit including the typical and observed fruit shape, length, diameter, weight, number per cluster or single, skin and flesh coloration with reference to the employed color chart, acidity, brix, aroma, taste. The recitation “Similar to *Prunus avium*” is vague and insufficient in this instance.

R. Page 3, lines 28 and 29, Applicants state flower arrangement and shape are “Similar to *Prunus avium*”. Applicants should set forth in the specification the instant plant’s typical and observed flower arrangement and shape. The recitation “Similar to *Prunus avium*” is vague and insufficient in this instance.

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S. Page 3, line 30 to page 4, line 3, Applicants should set forth in the specification additional information relative to the instant plant's bud including the typical and observed bud shape.

T. Page 4, lines 2 and 3, Applicants state closed bud and before bursting bud color is "Yellow-brown" and "Greenish brown", respectively. Applicants should set forth in the specification a color designation for the "Yellow-brown" and "Greenish brown" colorations. The recitations "Yellow-brown" and "Greenish brown" are vague and insufficient in these instances.

U. Page 4, lines 5, Applicants state lastingness of bloom is "Two to three weeks". It is not understood whether applicants intend this recitation to mean the entire tree is in bloom for two to three weeks or one bloom lasts two to three weeks. Applicants should set forth in the specification the time the entire plant is in bloom and the lastingness of an individual bloom.

V. Page 4, lines 9 and 10, Applicants should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal length, width, apex and base descriptors, texture, and coloration (upper and lower surfaces) with reference to the employed color chart.

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W. Applicants should set forth in the specification information relative to the instant plant's sepal, if produced, including the typical and observed sepal number, shape, length, diameter, apex and margin descriptors, and coloration (both surfaces) with reference to the employed color chart.

X. Page 4, lines 12 and 13, Applicants state flower upper surface and lower surface color is "White". Applicants should set forth in the specification a color designation for the "White" colorations. The recitation "White" is vague and insufficient in these instances.

Y. Page 4, lines 19 and 20, Applicants state upper and lower surface peduncle color is "Yellow-green" and "Yellow to brownish green", respectively. Applicants should set forth in the specification a color designation for the "Yellow-green" and "Yellow to brownish green" colorations. The recitations "Yellow-green" and "Yellow to brownish green" are vague and insufficient in these instances.

Z. Page 4, line 21, Applicants state the instant plant's natural flowering season is "Comparable to *Prunus avium*". Applicants should set forth in the specification the month or months the instant plant blooms if different than what applicants have previously stated, "April",

Detailed Action

page 4, line 4. The recitation “Comparable to *Prunus avium*” is vague and insufficient in this regard.

AA. Page 5, lines 10 and 11, Applicants should set forth in the specification the typical and observed number of pistils per flower.

AB. Applicants should set forth in the specification information relative to the instant plant’s seed including the typical and observed shape, length, diameter, and coloration with reference to the employed color chart.

AC. Applicants should set forth in the specification information relative to the instant plant’s pedicels, if produced, including the typical and observed length, diameter, and coloration with reference to the employed color chart.

AD. Applicants state color references are primarily to the R.H.S. Colour Chart. However, nowhere in the specification, Claim, or abstract has applicant used the referenced Color Chart. Applicants should utilize the referenced Color chart so as to provide an adequate color description for the characteristics noted in the above paragraphs.

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AE. Page 6, The Claim, lines 1 and 2, Applicants should delete “used as rootstock” as this information has already been stated in the specification. The Claim encompasses the entire plant which was described in the specification.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Applicants should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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Applicants should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (571) 272-1600.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell